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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Monica J.. ROTH, *et al.*

SERIAL NO. : 09/881,572

EXAMINER : T.D. Wessendorf

FILED : June 14, 2001

ART UNIT : 1639

FOR : TARGETING VIRAL VECTORS TO SPECIFIC CELLS

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

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Lois Snure

(Name of Person depositing correspondence)

Lois A. Snure 12/26/02
(Signature and Date)

RESPONSE TO RESTRICTION REQUIREMENT
UNDER 35 U.S.C. §121

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Dear Sir:

This is in response to a Requirement for Restriction mailed November 25, 2002, having a period for response set to expire December 26, 2002, December 25 being a National Holiday, requiring Applicant to elect between the following groups of claims for further prosecution:

Group I - Claims 1-4, 10, drawn to a retroviral display library.

Group II - Claims 5-7, drawn to a retroviral envelope library.

Group III - Claims 8-10, drawn to a retroviral nucleic acid library.

Group IV - Claims 11-14, drawn to a method of creating a viral display library.

Group V - Claims 15-19, 26, drawn to a method of isolating a virus.

Group VII - Claims 20-26, drawn to a method of transmitting non-viral n.a. to a cell.

Group VIII - Claims 27-30, drawn to a method of screening.

In accordance with 35 U.S.C. §§121 and 372, Applicants hereby elect to prosecute the claims of Group V, drawn to a method of isolating a virus, with traversal.

The examiner has also requested applicants to elect a species of virus, and applicants elect retroviruses.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one application may ... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Under Patent Office examining procedures, "If the search and examination of an entire application can be made without serious burden, the Examiner is encouraged to examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988).


Specifically, applicants submit that at least the claims of Groups I-III have subject matter that is sufficiently common as to facilitate conjoint search and consideration. On this basis, applicants request that the examiner reconsider and modify the present requirement so as

to ease the future burden on applicants with respect to the prosecution of the subject matter that is presently non-elected. For this reason, Applicants traverse the outstanding requirement and request its withdrawal.

For the above reasons, Applicants request withdrawal of the Requirement for Restriction, and early action on the merits as to all of the claims presently pending in the case.

In view of the above, early action on the merits is courteously solicited.

Respectfully submitted,



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